

Remarks

Claim 1 remains pending in this application. Claim 1 stands rejected under 35 U.S.C. § 102(e).

Rejections under Obviousness-Type Double Patenting

The Examiner has rejected claim 1 of the present application for obviousness-type double patenting over various patents and patent applications as follows:

A. The Examiner has rejected claim 1 for obviousness-type double patenting over claim 1 of U.S. Patent No. 5,604,116. Applicant has filed herewith a terminal disclaimer between the present application and U.S. Patent No. 5,604,116.

B. The Examiner has rejected claim 1 for obviousness-type double patenting over claim 15 of U.S. Patent No. 5,677,149 because the instant application is fully disclosed in the patent and is covered by the patent. The Examiner maintains the patent and the application claim common subject matter because the patent recites that the IL-3 mutant has an increased proliferative activity. The Examiner further states that both the IL-3 of the patent and the present application have substitutions at position 101 and therefore, it would be expected that the compound would have increased affinity.

However, the claimed proteins in US Pat No. 5,677,149 are IL-3 variants where native IL-3 has been truncated having the first fourteen and the last eight amino acid positions deleted together with other amino acid substitutions made at various positions. Hence, for the claimed proteins in the issued patent, position 87 corresponds to position 101 of native IL-3, and position 102 corresponds to 116 of native IL-3. Furthermore, at position 87, the amino acid is Asp and at

position 102, the amino acid is Lys. Therefore, a terminal disclaimer between the present application and U.S. Patent No. 5,677,149 is not required.

C. The Examiner has rejected claim 1 for obviousness-type double patenting over claim 1 of U.S. Patent No. 6,153,183. The Examiner maintains the patent and the application claim common subject matter because the patent recites that the IL-3 mutant has an increased proliferative activity. The Examiner further states that both the IL-3 of the patent and the present application have substitutions at position 101 and it would be expected that the compound would have increased affinity.

However, in the proteins claimed in US Pat No. 6,153,183, Asp is at position 101 and Lys is at position 116. In addition, claim 1 of this patent has a typographical error in identifying Asn instead of Asp which can be evidenced by a quick review of the remaining claims. Therefore, a terminal disclaimer between the present application and U.S. Patent No. 6,153,183 is not required.

D. The Examiner has rejected claim 1 for obviousness-type double patenting over claim 1 of U.S. Patent No. 6,458,931. Applicant has filed herewith a terminal disclaimer between the present application and U.S. Patent No. 6,458,931.

E. The Examiner has rejected claim 1 for obviousness-type double patenting over claim 1 of U.S. Patent No. 5,817,486. Applicant has filed herewith a terminal disclaimer between the present application and U.S. Patent No. 5,817,486.

F. The Examiner has rejected claim 1 for obviousness-type double patenting over claim 24 of U.S. Patent Appl. No. 08/466,631. Applicant has filed herewith a terminal disclaimer between the present application and U.S. Patent Appl. Nos. 08/466,631.

The Examiner has rejected claim 1 for obviousness-type double patenting over claim 14 of U.S. Patent Appl. No. 08/466,648. Applicant has filed herewith a terminal disclaimer between the present application and U.S. Patent Appl. Nos. 08/466,648.

The Examiner has rejected claim 1 for obviousness-type double patenting over claim 40 of U.S. Patent Appl. No. 08/468,588. Applicant has filed herewith a terminal disclaimer between the present application and U.S. Patent Appl. No. 08/468,588.

The Examiner has rejected claim 1 for obviousness-type double patenting over claim 24 of U.S. Patent Appl. No. 08/469,317. Applicant has filed herewith a terminal disclaimer between the present application and U.S. Patent Appl. No. 08/469,317.

Rejection under 35 U.S.C. § 102(e) over Vadas et al.

The Examiner has rejected claim 1 under 35 U.S.C. § 102(e) as being anticipated by Vadas et al. Vadas et al. is not prior art under 102(e) because Vadas et al. has a priority date of June 20, 1994 and the present application has a priority date of November 24, 1992.

Vadas et al. has a 102 (e) date of June 20, 1994. In the present application, support for claim 1 may be found in the parent application U.S. Patent Appl. 07/981,044 filed November 24, 1992. On page 10 of U.S. Patent Appl. 07/981,044, an hIL3 variant having a replacement of one or both of the residues Asp¹⁰¹ and Lys¹¹⁶ is described. Specifically, an Ala at position 101 and a Val at position 116 is taught. In addition, "[m]any or all of these biological activities of hIL-3

involve signal transduction and high affinity receptor binding" is taught on page 4 of this application. Therefore, Vadas et al. does not anticipate the claim of the present application.

Rejection under 35 U.S.C. § 102(e) over Bauer et al.

The Examiner has rejected claim 1 under 35 U.S.C. § 102(e) as being anticipated by Bauer et al. Bauer et al. is not prior art under 102(e) because it has a priority date of April 6, 1995 and the priority date of the present application is November 24, 1992.

Bauer et al. has a 102 (e) date of April 6, 1995. The support for claim 1 of the present application may be found in the priority application, U.S. Patent Appl. 07/981,044 filed November 24, 1992. On page 10 of the parent application, an hIL3 variant having a replacement of one or both of the residues Asp¹⁰¹ and Lys¹¹⁶ is described. Specifically, an Ala at position 101 and a Val at position 116 is taught. In addition, "[m]any or all of these biological activities of hIL-3 involve signal transduction and high affinity receptor binding." is described on page 4 of this application. Therefore, Bauer et al. does not anticipate the present application under 102(e).

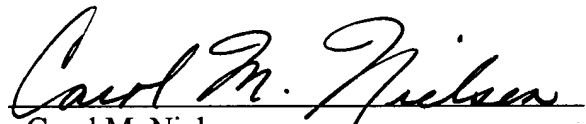
Conclusion

Applicant respectfully requests reconsideration of the application in light of foregoing remarks. The present paper is believed to constitute a complete response to the Office Communication mailed February 14, 2005.

The Director is hereby authorized to charge any fees or credit any overpayment to Deposit Account Number 23-2426 of WINSTEAD SECHREST & MINICK P.C (referencing number 43392-P005P1C1).

Respectfully submitted,

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Carol M. Nielsen
Attorney for Applicant
Registration No.: 37,676

Winstead Sechrest & Minick P.C.
2400 Bank One Center
910 Travis Street
Houston, TX 77002
713-650-2722 phone
713-650-2400 fax
cnielsen@winstead.com

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